

REMARKS

Claims 1-8 and 14-17 were pending prior to entering this amendment. Claims 1-8 and 14-17 stand rejected. The specification is objected to. Claims 1-8 and 14-17 stand rejected under 35 U.S.C. § 112, first paragraph. Claims 1 and 14-15 stand rejected under 35 U.S.C. § 102(e). Claims 2, 4, 5-8 and 16-17 are rejected under U.S.C. § 103(a).

Amendments to the claims are proposed that would place the application in better form for Appeal by eliminating several §112 issues. Entry of these Amendments is respectfully requested.

Reconsideration is requested. No new matter is added. The rejections are traversed. Claims 1 and 14 are amended. Claims 1-8 and 14-17 remain in the case for consideration.

OBJECTIONS TO THE SPECIFICATION

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter, particularly the limitation “operating . . . the data mining code.”

As noted below with reference to the § 112 ¶1 rejection, the disclosure on page 2, lines 22-31 (describing the operational details of the “small piece of code . . . cop[ied] and paste[d] into the web page . . . for which monitoring is desired) and on page 10, lines 8-12 (describing the “data mining code” as code distinct – but not necessarily separate – from the web page and cookie processing script. “Operating” the code on the computer downloading the web page + additional JavaScript is implied as understood within the art, since the generally understood behavior of a browser is to operate the code downloaded with the web page.

Removal of the objection is requested.

REJECTIONS UNDER 35 U.S.C. § 112 ¶1

Claims 1-8 and 14-17 are rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement.

The specification, particularly beginning at page 10, lines 8-12, mentions data mining code and refers to it as distinct from “the original web page code” and “additional cookie processing code supplied by the web tracking provider.” The data mining code refers to the “JavaScript code,” where a web site operator “copies and pastes this code onto each web page maintained on server 12 for which monitoring is desired.” Page 2, lines 23-24. Based on the

description provided within the specification and the knowledge of the art at the time the patent application was filed, one with knowledge in the art would understand how the data mining code would be constructed and added into the original web page code.

Removal of the rejections is thus requested.

REJECTIONS UNDER 35 U.S.C. § 112 ¶2

Claims 1-8 and 14-17 are rejected under 35 U.S.C. § 112, second paragraph as having insufficient antecedent basis for “new cookie” (claims 1-8) or is otherwise unclear with respect to the element “web page” (claims 14-17).

Claims 1 and 14 have been amended to address these issues and removal of the rejections is thus requested.

REJECTIONS UNDER 35 U.S.C. § 102(e)

Claim 1 is rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,085,224 to Wagner.

The section cited by the Examiner only appears to teach standard cookie setting, as via name-value pairs, and not cookie processing script as contemplated within the invention. Further explanation is included below.

A. The teachings of the cited Wagner reference seek to prevent operation of cookies, not implement them as in the present invention

Claim 1 has been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,085,224 (Wagner). . Claims 2-8 have been rejected under §103(a) under Wagner in view of other references as follows:

- Claims 2 and 5-8 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner as applied to claim 1 above, and further in view of U.S. Patent No. 6,112,240 (Pogue, et al.).
- Claim 3 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner and Pogue as applied to claims 1 and 2 above, and further in view of U.S. Patent Application Publication No. 2002/0040395 (Davis, et al.).
- Claims 4 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner, Pogue and Davis as applied to claims 1-3 above, and further in view of U.S. Patent No. 6,374,359 (Shrader, et al.).

- Claim 5 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner, Pogue and Davis.

The claims are being rejected strictly on the disclosure contained in the Wagner reference's Background section rather than in its improvement over the prior art.

Whereas the present invention is directed to tracking user browsing behavior, the Wagner reference seems dedicated to preventing such tracking. In its Background Section, Wagner references the potential harm caused by cookies:

While the storage of a cookie file may appear harmless, it is nevertheless the unauthorized storage of data on another's computer and the file may be used for tracking the user and his or her requests for information from the server site without the user's knowledge or permission. [Wagner, col. 2, lines 49-53]

Wagner then notes that prior art programs have been developed that monitor the HTTP headers and delete cookie data from these headers. These prior art programs, however, are incapable of deleting either inbound or outbound cookie data when sent via interpretive languages such as Javascript:

While these previously known programs may be used to selectively notify a user of the presence of cookie data from an HTTP header, these programs do not detect other hidden data which a user may want to know is being passed to the user's browser or want to delete from an HTML file or request. [Wagner, col. 3, lines 8-14]

While applets have a number of beneficial purposes, they may also cause problems. For example, a JAVA applet may be imbedded in an HTML file, sent to a user's computer and executed by an interpreter in the browser without the user's knowledge....Additionally, these interpretive language programs may include cookie commands that identify tracking data as discussed above. [Wagner, col. 3, lines 34-41]

The end result is that since the cookie commands are not part of the HTTP header, then prior art programs that would ordinarily be used to detect and delete cookie data are incapable of detecting cookie commands. Wagner then mentions that browsers have been rewritten to include a feature that disable the execution of interpretive programs and cookie commands, similar to that described in Applicant's Background section on page 3 of the patent application. Whereas the present invention seeks a workaround to this type of modified browser function, the Wagner reference seeks to enhance the exclusion of cookie commands by adding a user notification step:

What is needed is a program which notifies the user of detected interpretive programs and cookie commands without modifying the browser program. What is needed is a way to restrict access to resources or data on a computer when the computer is in communication with another computer. [Wagner, col. 4, lines 4-9]

The present invention and Wagner thus appear to be on different sides with respect to the issue of cookies. Whereas the present invention seeks to store a cookie on a web site visitor's computer, the Wagner reference seeks to prevent that from happening.

B. Wagner does not teach including data mining code and cookie processing script within a web page per claim 1

Claim 1 includes the step of storing a web page on a server where the web page includes data mining code and cookie processing script. Despite the additional overhead of adding script to a web page and thus increasing download times, including the script gives the web site owner an advantage of gleaning web site traffic information from the visitor. Such information would assist the web site owner in tailoring their web site to reach and appeal to the broadest range of customers.

In contrast to the present invention, Wagner discloses a program that is used to delete cookies and/or prevent them from operating. Accordingly, the web site owner would gain no additional knowledge from the web site visitor by embedding the Wagner program into their web pages. There would then be no motivation for including a cookie disabling and notification program such as described in Wagner within a web page as this works counter the web site owner's desire to obtain information from the visitor, whether voluntarily or automatically. It is thus factual error to ascribe the teaching of embedding data mining code and cookie processing script into the web page itself.

Although the Wagner invention itself does not teach including additional script within a web page, prior art methods noted in the Wagner Background section do. The Examiner cites to col. 3, lines 15-41 of the Wagner Background section in which a JAVA applet within an HTML file is executed by the browser to include a cookie command. There is no reason to believe, however, that these cookie commands are nothing more than standard cookie storing commands. The operation of such standard cookies is described in applicant's patent application, particularly on page 5. In such standard cookies commands, name-value pairs (e.g. UserID and a long hexadecimal number) are generated according to an algorithm programmed in the cookie server associated with the domain web site. This unique name-value pair is then stored in a cookie file at the visitor computer and sent back to the domain that set the cookie upon each request for information, like an ID badge at a conference. The domain then knows who is requesting the information and can track a visitor's behavior at the web server across several visits. All traffic

tracking information is conducted at the web server. There is no mechanism within Wagner for allowing a third party to track the information (e.g. claim 2).

Standard cookies and cookie-setting processes do not operate cookie processing script on the web browsing data to obtain new cookie values (e.g. claim 1). Instead, cookie values are set in advance by a cookie server. Such values are not determined at the visitor computer, and such values are not set in consideration of the web browsing data obtained at the visitor computer via the data mining code. Features of the claim are thus missing from Wagner and thus the prior art of record. Reconsideration and removal of the rejection is respectfully requested.

C. Bharat still fails to teach elements of claim 14 on its own

Claims 14 and 15 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,810,395 to Bharat.

The Examiner had previously held, in an Office Action dated May 18, 2007, that Bharat fails to teach the method of embedding data mining script within a web page and operating the data mining script on the client node. Bharat still fails this test, making rejection of the claims under §102(e) inappropriate.

Claim 14 had been amended in a previous action to cite that the cookie processing script is associated with a different domain than the web page—that is, where the web page provider and the (web tracking) service provider are different entities. Neither Bharat (or the old-cited l'Etraz) contemplate this feature.

REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 2 and 5-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner as applied to claim 1 and further in view of U.S. Patent No. 6,112,240 to Pogue et al.

Claims 16 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bharat as applied to claim 14 and further in view of Pogue et al.

Claims 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner and Pogue as applied to claims 1 and 2 and further in view of U.S. Patent Publication No. 2002/0040395 to Davis et al.

Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner, Pogue et al. and Davis et al. as applied to claims 1-3 and further in view of U.S. Patent No. 6,374,359 to Shrader et al.

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner, Pogue et al and Davis et al.

Because of deficiencies in the prior art with respect to the §102(e) rejections noted above, not all elements of the claims are taught and therefore rejection under §103(a) would be improper. Appropriate correction is required.

For the foregoing reasons, reconsideration and allowance of claims 1-8 and 14-17 of the application as amended is requested. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

A handwritten signature in dark ink, appearing to read 'Scott A. Schaffer', is written over a horizontal line.

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